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| 10/085,125      | 03/01/2002  | Tomoaki Umeda        | Q66588              | 3925             |

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SUGHRUE MION, PLLC  
2100 Pennsylvania Avenue, NW  
Washington, DC 20037-3213

EXAMINER

SAX, STEVEN PAUL

|          |              |
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| ART UNIT | PAPER NUMBER |
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2174

|           |               |
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| MAIL DATE | DELIVERY MODE |
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07/17/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                       |  |
|------------------------------|--------------------------------------|---------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/085,125 | <b>Applicant(s)</b><br>UMEDA, TOMOAKI |  |
|                              | <b>Examiner</b><br>O'Neal R Mistry   | <b>Art Unit</b><br>2174               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03/01/02 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. This application has been examined.
2. Claims 1, 3-34 are presented for examination.

***Priority***

3. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 057568/2001 Japan, filed on 3/02/2001.

***Drawings***

4. The Examiner contends that the drawings submitted on 3/02/2001 are acceptable for the examination proceedings.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson (U.S. Patent Application 2002/0105658) in view of Fredlund et al (U.S. Patent Number 5,66,215) and Umebayashi (6515765).

In regards to claims 1, 4, & 7, Jackson discloses a data management method comprising the steps of: displaying on a display means an icon corresponding to a data management unit with which data can be registered (paragraph 32 lines 1-6) [In block 105 of FIG. 2, the customer selects images to be uploaded from the home computer 10 to the fulfillment center 40, in order to be stored by the service provider, and possibly utilized in the future to produce one or more photo products. In a preferred embodiment, the CPU 12 displays on the display monitor 14 a display screen 400 as shown in FIG. 7.]. The examiner interprets that the limitation recites displaying on screen a set of data, which can be icons, that represent digital images on a computer. In addition Jackson states carrying out a simple output of the data registered with the data management unit to the display means by opening the icon (paragraph 22 & paragraph 68) [FIG. 7 is a graphical user interface screen to enable a user to select

images to be uploaded] & [As in block 105, this can be done by selecting to upload all the images from a particular CD inserted in CD reader 2 or stored in digital camera 6 or by individually selecting images to be uploaded.]. The examiner interprets that after the user selects images to be uploaded that the uploaded images are opened icons on the data management unit.

The difference between the claims and Jackson is the claims recite "registering the data with the data management unit by carrying out a drag-and-drop operation for the data onto the icon;"

Fredlund teaches a method to allow a customer to place an order of prints via a personal computer or a kiosk work station similar to that of Jackson. In addition, Fredlund discloses registering the data with the data management unit by carrying out a drag-and-drop operation for the data onto the icon (col. 5 lines 38-44) [The customer then identifies one of the images using a standard drag and drop computer interface or set-top box selection mode, for example by clicking on one of the images with a mouse or trackball and dragging it into the large display area 56, or by entering the desired frame number on a remote control device if the program is implemented via a set-top box.];

It would have been obvious to a person of ordinary skill in the art, having the teachings of Jackson and Fredlund before him at the time the invention was made, to modify the mouse clicking method for selecting images taught by Jackson to include the

mouse capabilities of dragging and dropping as a method for selecting images of Fredlund, in order to obtain a system that allows a user to drag and drop images from a graphical user interface for selecting a print orders to be sent via a network.

It would have been advantageous for one to utilize such a combination for the reason that there is a desirable need to have an improved system and method for facilitating ordering and re-ordering of prints, and other images, which are from Photo CD™ or digital cameras, or related services from negatives.

Neither Jackson nor Fredlund go into the details that the data are image data and the simple output is displaying a thumbnail image or thumbnail images of the image data that have been registered with the data management unit; and displaying input fields for inputting print quantities corresponding to the thumbnail image or the thumbnail images, but do discuss efficient presentation of data to be managed. Furthermore, Umebayashi does show this for efficient presentation of data to be managed (abstract, Figures 1,4, paragraphs 15, 37, 40). It would have been obvious to a person with ordinary skill in the art to have this in the invention of Jackson as modified by Fredlund, because it would allow efficient presentation of data to be managed.

5. In regards to claims 5 & 8, Jackson in view of Fredlund states the data are image data and the simple output is displaying a thumbnail image or thumbnail images of the image data that have been registered with the data management unit (paragraph 39 lines 7-12) [The display screen 400 includes a two-dimensional array of thumbnail images 402 obtained from the digital camera 6, the

CD reader 2, or the hard drive 20. The thumbnail images 402 preferably are thumbnail images stored within the Exif/JPEG image files provided by the digital camera 6].

6. In regards to claim 3, 6, & 9, Jackson in view of Fredlund discloses displaying on the display means, in the case where a plurality sets of the image data have been registered with the data management unit, an order screen for all the image data sets together with the thumbnail images thereof, (paragraph 39 line 13- paragraph 40 line 4) [The user selects all of the images, or a subset of the images, by clicking the mouse 18 on the "select all" icon 432, or on any number of thumbnail images 402. FIG. 7 shows that four thumbnail images 402a, 402b, 402c, and 402d (which are outlined) have been selected. In order to select desired images from a large number of thumbnail images 402, arrow controls 404 on the right portion of display screen 400 enable the user to scroll through the larger number of thumbnail images 402];

receiving an input of the content print order for the image data sets (paragraph 50 lines 1-5 & Figure 2) [In block 120, the user selects the images to be used to produce the photo products they have selected. The selection is accomplished using the mouse 18 or keypad 16 to identify appropriate images. This can be done as described earlier in relation to FIG. 7]. The examiner interprets on Figure 7 after the

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user has selected the images, style of the images, and frames for the images, this is the entire content of the print order for the image sets; and

generating order information representing the content of the print order for the image data sets (paragraph 51 lines 1-5, Jacksone, & Figure 4, Fredlund)

[Information describing the products selected by the user] can be stored in the service account information depicted in FIG. 5.

As shown in the example depicted in FIG. 5, the service account information includes the user name, password, user e-mail address, user shipping address, and billing information (lines 3-7) .]. The examiner also interprets that after the print order is created, the personal information of user who desired to execute the print order is also included, the personal information is stored on secure database.

7. Applicant's arguments with respect to the claim have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within



TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven P. Sax whose telephone number is (571) 272-4072. The examiner can normally be reached on Monday thru Friday, 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on (571) 272-4063. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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STEVEN SAX  
PRIMARY EXAMINER